In re Application of: Levitzki et al
Serial No.: 10/715,547
Filed: November 19, 2003
Office Action Mailing Date: January 8, 2008

Examiner: Tamthom N. Truong
Group Art Unit: 1624
Attorney Docket: 27148

REMARKS

Reconsideration of the above-identified application in view of the amendments above and the remarks following is respectfully requested.

Claims 1-5 and 9-34 are in this case. Claims 4, 5, 12-27 and 32-34 have been withdrawn from further consideration as being drawn to a non-elected invention. Claims 1-3, 9-11 and 28-31 have been examined on the merits. Claims 1-3, 9-11 and 28-31 have been rejected. Claims 1 and 28 have been amended herewith.

35 U.S.C. § 112 Second Paragraph Rejection

The Examiner has rejected claims 1-3, 9-11 and 28-31 under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Claims 1 and 28 have been amended.

Specifically, the Examiner has noted as evidence that claims 1-3, 9-11 and 28-31 fail to correspond in scope with that which Applicant regards as the invention, and quoted Applicant's reply filed 10-15-07, where Applicant has defined the term "a pair of electrons", and that this statement indicates that the invention is different from what is defined in the claims because as drawn, Compound II is presumed to be a compound that is fully aromatic, and thus, the limitation of "a pair of electrons" as stated in the main claim 1 would seem to only apply for each of A, D and Y (all being N) when said atoms are doubly bonded to adjacent atom. The Examiner further stated that when said atoms are singly bonded to adjacent atom (i.e., B for A & D, and carbon for Y), then these atoms would have to be bonded with "R" moieties, however, for "B" as limited to carbon, R2 can never be a "pair of electrons" but rather a substituent to fulfill valency requirements, and that for all of the above reasons, the claim language needs to be verified.

Applicant has chosen to amend claims 1 and 28 so as to no longer encompass a possibility of having a pair of electrons on a carbon atom which is a member of an aromatic ring. Applicant believes to have overcome the Examiner's 35 U.S.C. 112, second paragraph rejections.

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35 U.S.C. § 112 First Paragraph Rejection

The Examiner has stated that claims 1-3, 6-11 and 28-31 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner's rejection is traversed respectfully.

Specifically, the Examiner has stated that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner has added that although Compound II is defined (as pointed out by applicant), the specification does not provide a generic process of making Compound II, nor does it provide bioavailability as well as working examples, and added that due to the different positions of Y's, the generic process of making Compound I cannot be applied to Compound II and thus, it is maintained that the specification fails to provide written description for Compound II or preparation thereof.

Applicant contends that the examples presented in the specification of the instant application are more than ample to provide any person skilled in the art the necessary guidelines to prepare species encompassed under Compound II, such as those illustrated for example in Scheme I (see, page 63) and Scheme II (see, page 65). In these two examples, a skilled artisan can easily recognize the well established synthetic path for forming a heteroaryl by the cyclo-addition of two compounds, namely the coupling of a benzene-1,2-diamine derivative with a phenyl glyoxal (Scheme I) or thiophene glyoxal (Scheme II) to form a quinoxaline derivative, and thus any artisan would be prompted to prepare a corresponding quinazoline derivative from a 2-(2-aminophenyl)acetaldehyde derivative and an amide such as benzamide.

Applicant further contends that patent applicants are not required to disclose every species encompassed by their claims. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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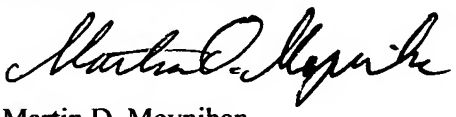
In view of the above amendments and remarks it is respectfully submitted that amended claim 1, claims 2-3 and 9-11, amended claim 28 and claims 29-31 are now in condition for allowance. Prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,



Martin D. Moynihan
Registration No. 40,338

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Encls.:

- Petition for Extension for Three Months Time
- A Request for Continued Examination (RCE)